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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,122

Applicant(s)

WOLF ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is responsive to communication filed March 17, 2004.

Response to Arguments

Applicant's arguments, see paper #24, filed March 17, 2004, with respect to the rejection(s) of claim(s) 1 and 17 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Forward.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 recites the limitation "accepting the rebate coupon by the seller during a tour" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 17 recites, "processing rebate coupons by the host for properties selected for tour". However, does not recite providing the seller with the rebate coupon, for the seller to accept the rebate coupon. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-18, 20-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Forward U.S. Patent No. 6,578,011.

Regarding claims 1, 6-8 and 29, Forward teaches a remote communications facility including input-output (see fig.1); a host system including (i) a data storage means for maintaining databases containing a plurality of data records of different types and chronologies (see fig. 2); (ii) computer processing for selecting data records and transmitting the selected data records to at least one remote communication facility according to selected criteria provided by one of the remote communications facility (see fig. 3); (iii) communication network to exchange data between the host and remote communications facility (see fig.2); wherein a potential buyer without the aid of a field agent uses at least one input-output means to do one of (i) specify said selection criteria for the data records, obtain display of selected data records meeting the selection criteria and obtain one of said first rebate coupon from said host system for at least one property corresponding to said selected

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data records ... **OR** (ii) present to the host at least one second rebate coupon ... Forward teaches the web site providing an incentive information (29) to the buyer, the information indicating of an incentive that will be provided through the host if the buyer purchases the item. Forward teaches the incentive comprising of any thing of value that would encourage a purchaser to purchase the item of interest, for example, a rebate, a reward, a cash offer etc, (see col. 5 lines 20-50 and col. 8 lines 18-24). Forward also teaches the buyer transmitting an incentive execution request to the host along with a purchase certificate (contract, electronic certification or a hard copy) and the host providing incentive execution to the buyer. The incentive execution (36) comprising of electronic certificate, identification number, check, coupon or any other device that buyer may use to execute the incentive with a third party or deliver the incentive directly (see col. 6 lines 42-52). The incentive execution (36), which comprise of coupon), which provides a rebate to the buyer, is the same as the rebate coupon. Therefore Forward teaches a first rebate coupon registered and stored in the database. Wherein the first rebate coupon is defined such that seller agreed or subsequently agree to perform acceptance of the coupon as substitute for an agent and to fund a commission to the host for the sale of a property (see abstract and col. 5 lines 32-50). The claim recites an alternate limitation and only one of the features needs to be taught by the prior art. When the alternative feature is not performed (when the second rebate coupon is not presented or entered to the host), the host does not store the second rebate coupon. Therefore, patentable weight was not given to “registering and storing of the second coupon”.

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Regarding claims 2, 3 and 10, Forward teaches remote communications facility provides means for the buyer to indicate properties visited accepted, specify and capture (see col. 5 line 51 to col. 6 line 52).

Regarding claim 4, Forward teaches provides means for seller to specify selection criteria for the data record and to display selected data records meeting the selection criteria (see col. 4 line 14 to col. 5 line 19).

Regarding claim 5, Forward teaches data exchange through the Internet and a web browser (see col. 3 line 52 to col. 4 line 23).

Regarding claim 9, Forward teaches receiving and storing data relating to buyers, to form a buyer profile (see col. 7 lines 4-26).

Regarding claim 11, Forward teaches ranking the data using pricing and demographic data prior to transmitting the data to the remote communication facilities (see col. 5 lines 4-19).

Regarding claim 12, Forward show the aggregation of selected records into a group (see col. 4 line 13 to col. 5 line 3-19).

Regarding claims 13-16, Forward teaches performing real estate transaction and automatically determining commission to be paid to company and dollars to be paid to sales agents and other agencies and accounting facilitated by the system; payment by the host of a rebate to the buyer (see col. 2 line 27 to col. 3 line 35 and col. 5 line 60 to col. 7 line 3).

Regarding claims 17, 18, 25 and 27, Forward teaches a host system for signing up seller to pay commission to the host; obtaining a listing of inventory of property to be sold; maintaining database at the host which contain data records of different types and chronologies (see abstract and col. 4 line 32 to col. 5 line 50); processing rebate coupon by

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the host for properties selected to tour (see col. 6 lines 42-52); users remotely accessing via a communication network, Internet, to specify selection criteria to search the database...and delivering results of the search; recording each step of the method information in the data records; ranking of each search results with formula ... (see fig. 1-3 and col. 5 lines 4-19).

Regarding claims 20 and 21, Forward teaches generating a rebate coupon and delivering to remotely accessing user (see col. 6 lines 42-52).

Regarding claims 22-24, Forward teaches designating the host system as cooperating broker; buying the property by the potential buyer; pay of the buyer rebate when the seller pays the commission; invoicing the host of the seller of the broker's commission (see Fig. 1-4 and col. 5 lines 61 to col. 6 line 52).

Claim 26 is rejected as stated above in claim 12.

Claim 28 is rejected as stated above in claim 9.

Regarding claim 30, Forward teaches seller agree to list properties ... (see col. 2 lines 42-64 and col. 4 line 33 to col. 5 line 3).

Allowable Subject Matter

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Claims U.S. Patent No. 6,173,267 teaches processing rebate.

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Holda-Fleck U.S. Patent No. 5,729,693 teaches automatically providing an electronic consumer rebate.


Flaten U.S. Patent No. 5,467,269 teaches telephonically crediting customers with rebates and refunds.

Small U.S. Patent No. 5,791,991 teaches interactive consumer product promotion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yehdega Retta
Examiner
Art Unit 3622

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